

REMARKS

I. Summary of the Office Action

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 are pending in this application.

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, 62, and 63 were rejected under 35 U.S.C. § 103(a) as being obvious from Young et al. U.S. Patent No. 5,353,121 ("Young") in view of Goldschmidt Iki et al. U.S. Patent No. 6,483,987 ("Iki") and Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond").

Claims 60 and 61 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki, Zigmond, and further in view of Michaud WIPO Publication No. WO 99/57904 ("Michaud").

Claims 8, 35-36, 41, 44-48, and 60-63 were objected to for informalities.

II. Summary of the Applicants' Reply

Applicants have amended claims 1, 2, 6, 8, 11, 12, 14-18, 35, 36, 41, 44, 48, 60, 62, and 63 to more particularly define the claimed invention. Specifically, claims 8 and 41 have been amended to correct their respective claim dependencies. For at least this reason, the objection to claims 8 and 41 should be withdrawn. In addition, claim 35 has been amended to recite that a selected promotion is inserted at one of the beginning of the recorded selected program or the end of the recorded selected program. For at least this

reason, the objection to claims 35-36, 41, 44-48, and 60-63 should be withdrawn.

Support for amended claims 1 and 35 can be found at, for example, page 1, line 26 through page 2, line 5 of applicants' provisional Application No. 60/179,548 ("applicants' provisional application").

The Examiner's rejections are respectfully traversed.

III. Applicants' Reply to the § 112 Rejection

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly lacking antecedent basis for the term "the advertisement." Applicants have amended claims 1, 35, 62, and 63 to replace all references to "the advertisement" with a "selected promotion." For at least this reason, applicants respectfully submit that the Examiner's rejection of claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 under 35 U.S.C. § 112, second paragraph, be withdrawn.

IV. Applicants' Reply to the § 103 Rejection

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, 62, and 63 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki and Zigmond. Claims 60 and 61 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki, Zigmond, and Michaud. These rejections are respectfully traversed.

Applicants' independent claims 1 and 35 refer to, *inter alia*, a method and system for providing an integrated recorded program/promotion playback asset. The

program/promotion playback asset is a customized playback experience of recorded programming in that one or more promotions are insertably recorded with respect to the recorded programming such that during playback, the recorded promotion(s) appear as if they were originally part of the recorded programming. As required by independent claims 1 and 35, a selected promotion is inserted at one of the beginning of the recorded selected program or the end of the recorded selected program in response to determining that the selected program is to be recorded.

Young relates to a television schedule system that allows a user to control operation of a VCR through on screen television program listings (Young, 1:19-24).

Iki relates to a graphical user interface that allows a user to record a broadcast data selection without commercials by determining whether a commercial or program is being broadcast, and stopping the recording if a commercial is being broadcast (Iki, FIG. 7, 8:59-9:7 and 9:15-31).

Zigmond refers to a system that provides on-the-fly insertion of advertisements into a video programming stream at the household level. The advertisements are replaced during the broadcast of a program while the user is watching that program using a video switch that toggles between a real-time video programming feed and a real-time advertisement stream (Zigmond, 16:20-43).

On page 5 of the Office Action, the Examiner contends that Young and Iki disclose all of the elements of applicants' claims 1 and 35, but admits that they do not disclose applicants' previously claimed step of inserting the

advertisement at one of the beginning of the program or the end of the program To remedy this deficiency, the Examiner relies on Zigmond.

Applicants respectfully submit that whether taken alone or in combination, Young, Iki, and Zigmond fail to show or suggest every element of applicants' independent claims 1 and 35. Specifically, Young and Iki do not show, in response to determining whether a selected program is to be recorded, recording the selected promotion for inclusion in an integrated recorded program/promotion playback asset such that the selected promotion is inserted at one of the beginning of a recorded selected program or the end of the recorded selected program. In other words, nowhere does the combination of Young, Iki, and Zigmond show or suggest a causal link between selecting a program to record, and recording a selected promotion with the selected program in the manner specified by applicants' independent claims 1 and 35. This causal link is not mere happenstance, but an integral feature of applicants' claims, as it allows for the creation of a program/promotion playback asset that, when watched, is plainly different than if the user had been watching a program on live television or a recorded version of the live television program.

As discussed above, Young merely allows a user to control operation of a VCR through on screen television program listings. Nowhere does Young show or suggest a causal link between selecting a program to record on the VCR, and recording a selected promotion with the selected program. Further, Iki shows a recording scheme that either eliminates commercials from a recorded program, or allows for the recording of a

program with commercials. Iki does not show or suggest a causal link between selecting a program to record, and recording a selected promotion with the selected program. Instead, when a user of Iki wishes to record a program with commercials, Iki simply records the broadcast program - commercials and all. Applicants' claims patentably improve upon Iki, as they provide a user with selected promotions based on whether or not the program is being recorded. Accordingly, even if Young could be modified to include the features of Iki, which applicants maintain it could not, the combination would still fail to show or suggest recording a selected promotion with a selected program in response to determining whether the selected program is to be recorded as required by applicants' independent claims 1 and 35.

Further Zigmond refers to a completely different approach for replacing advertisements in a recorded program than the approach described in applicants' independent claims 1 and 35. As described above, Zigmond refers to a system that provides on-the-fly insertion of advertisements into a video programming stream at the household level. Nowhere does Zigmond show or suggest the selection of a promotion to be recorded with a program in response to determining that a selected program is to be recorded. Instead, Zigmond refers to replacing advertisements during the broadcast of a program while the user is watching that program. These advertisements are not insertably recorded with the program itself, but merely presented in the real-time programming feed using a video switch. Thus, Zigmond fails to show or suggest a causal link between selecting a program to record, and recording a selected

promotion with the selected program. Accordingly, even if Young and Iki could be modified with the features of Zigmond, which applicants maintain they could not, the combination would still fail to show or suggest recording a selected promotion with a selected program in response to determining whether the selected program is to be recorded as required by applicants' independent claims 1 and 35. As a result, whether taken alone or in combination, Young, Iki, and Zigmond fail to show or suggest every element of applicants' independent claims 1 and 35.

In addition, applicants respectfully submit that Iki and Zigmond teach away from applicants' claimed approach. Zigmond teaches away from applicants' claimed approach because presenting replacement advertisements in a real-time program feed results in a different end product than applicants' recorded program/promotion playback asset. Further, Iki's recording scheme teaches away from applicants' claimed approach because it either eliminates commercials from a recorded program, or allows for the recording of program with commercials. This recording scheme is the complete opposite of applicants' insertion of commercials into a recorded program. Thus, one skilled in the art faced with the problem of inserting selected promotions into recorded programs would not look to combine Iki with Young and Zigmond in order to realize applicants' claimed invention. Rather, one skilled in the art would use the recording scheme of Iki to allow a user to record programs without commercials. Accordingly, because Iki eliminates commercials rather than selecting commercials to

insert in a recorded program, Iki teaches away from being included in a combination with Young and Zigmond.

Finally, applicants' claims provide concrete advantages over the Examiner's proposed combination of Young, Iki, and Zigmond. Applicants' claims allow, for example, an advertiser to select a promotion for inclusion in an integrated recorded program/promotion playback asset with a program in response to that program being selected for recording. This feature allows advertisers to insertably record different promotions with the selected recorded program than if the promotions were inserted in the program during broadcast, as shown by Zigmond. For example, the promotion may be selected based on the content of the selected program. Alternatively, the promotion may be selected based on time or user demographics. These selections are enabled by the fact that applicants' claims specify that the selecting and recording of the promotion occur in response to determining whether a selected program is to be recorded, and would not be possible to implement in the Examiner's proposed combination of Young, Iki, and Zigmond without significant modification. For at least these reasons, applicants' claims patentably improve upon the Examiner's combination.

For at least the foregoing reasons, amended independent claims 1 and 35 and dependent claims 2, 6, 8, 11-18, 36, 41, 44-48, and 60-63, which depend from either amended independent claim 1 or 35, are not obvious from Young in view of Iki and Zigmond. This rejection should therefore be withdrawn.

V. Conclusion

In view of the foregoing, claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-63 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,
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